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EXAMINER

BEISNER, WILLIAM H

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 15, 16, 18-21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Law et al.(US 7,029,529).

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The reference of Law et al. discloses a device that includes a gripper (278) (See column 4, lines 1-16) that is capable of gripping and releasing a replicating pad (102, 108); a pad locating device (282, 280) (See column 4, lines 1-16) so configured as to align the pad (102, 108) in the gripper (278); a positioning device (140, 142) (See column 3, lines 13-43) so configured as to lift, lower and move the gripper (278) to a predetermined location.

The embodiment of Law et al. shown in Figure 2 differs from claim 15 by failing to disclose a pusher so configured as to push the pad (102, 108) downwardly whereby the pad is pushed downwardly once it has been positioned in the predetermined location and is in contact with the substrate.

The reference of Law et al. discloses that it is known in the art to provide the stamping head of the device with a pusher system (See Figure 7) for providing uniform contact force across the surface of stamp while in contact with a substrate (See column 8, lines 47-59).

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of embodiment 2 of the reference of Law et al. with a pusher system disclosed by the reference of Law et al. for the known and expected result of ensuring uniform contact force between the pad and substrate when the pad is in contact with the substrate. Note the device as modified above would be structurally the same as that instantly claimed. The device is capable of being used with “a compliant agar plate having one or more colony formed thereon extending upwardly from the agar plate” and the pusher is structurally capable of providing the contact motion required with respect the agar plate.

With respect to claim 16, the pusher includes an actuator (724) and pressure regulator (738).

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With respect to claim 18, the pad-locating device includes projections (280) extending upwardly therefrom.

With respect to claim 19, while the pad-locating device (280, 282) of the reference of Law et al. includes projections for locating the pad, the reference is silent as to the use of pins and blocks as the projections.

However, in the absence of a showing of unexpected results and/or criticality, it would have been obvious to one of ordinary skill in the art to determine the optimum shape of the locating members while providing the intended function of locating the pad within the holder. The use of pins and/or blocks over a solid wall would be preferable for the known and expected result of facilitating the manual removal of the pad from the holder since a solid wall construction would limit the handler's grip on the pad when in the holder.

With respect to claim 20, the reference of Law et al. discloses the use of a pad container (914).

With respect to claim 21, the gripper includes a vacuum (286) to hold the replicating pad to the gripper (278).

With respect to claim 27, first, the claimed device does not positively recite the replicating pad are part of the claimed invention in claim 15. As a result, the device of the modified primary reference is structurally capable of being used with a "disposable pad". Additionally, the pad of Law et al. (102,108) is considered to be a "disposable pad".

5. Claims 15, 16, 18-21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Law et al.(US 7,029,529) in view of Tolles et al.(US 6,443,823).

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The reference of Law et al. discloses a device that includes a gripper (278) (See column 4, lines 1-16) that is capable of gripping and releasing a replicating pad (102, 108); a pad locating device (282, 280) (See column 4, lines 1-16) so configured as to align the pad (102, 108) in the gripper (278); a positioning device (140, 142) (See column 3, lines 13-43) so configured as to lift, lower and move the gripper (278) to a predetermined location.

The embodiment of Law et al. shown in Figure 2 differs from claim 15 by failing to disclose a pusher so configured as to push the pad (102, 108) downwardly whereby the pad is pushed downwardly once it has been positioned in the predetermined location and is in contact with the substrate.

The reference of Tolles et al. discloses that it is conventional in the art to provide a carrier head (100) that includes a vacuum chuck with a pressure eject system (See column 8, line 63, to column 9, line 17) to remove a substrate from the head.

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the carrier head or gripper (278) of the reference of Law et al. with a pressure eject system for the known and expected result of providing a means recognized in the art to facilitate removal of the pad from the gripper (278) after use. Note the resulting structural modification as discussed above would be capable of functioning to press the pad downwardly against the substrate. Note the device as modified above would be structurally the same as that instantly claimed. The device is capable of being used with “a compliant agar plate having one or more colony formed thereon extending upwardly from the agar plate” and the pusher is structurally capable of providing the contact motion required with respect the agar plate.

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With respect to claim 16, the pusher includes an actuator (724) and pressure regulator (738).

With respect to claim 18, the pad-locating device includes projections (280) extending upwardly therefrom.

With respect to claim 19, while the pad-locating device (280, 282) of the reference of Law et al. includes projections for locating the pad, the reference is silent as to the use of pins and blocks as the projections.

However, in the absence of a showing of unexpected results and/or criticality, it would have been obvious to one of ordinary skill in the art to determine the optimum shape of the locating members while providing the intended function of locating the pad within the holder. The use of pins and/or blocks over a solid wall would be preferable for the known and expected result of facilitating the manual removal of the pad from the holder since a solid wall construction would limit the handler's grip on the pad when in the holder.

With respect to claim 20, the reference of Law et al. discloses the use of a pad container (914).

With respect to claim 21, the gripper includes a vacuum (286) to hold the replicating pad to the gripper (278).

With respect to claim 27, first, the claimed device does not positively recite the replicating pad are part of the claimed invention in claim 15. As a result, the device of the modified primary reference is structurally capable of being used with a "disposable pad". Additionally, the pad of Law et al. (102,108) is considered to be a "disposable pad".

Response to Arguments

6. With respect to the rejection of Claims 15, 16, 18-21 and 27 under 35 U.S.C. 103(a) as being unpatentable over Law et al.(US 7,029,529) and under 35 U.S.C. 103(a) as being unpatentable over Law et al.(US 7,029,529) in view of Tolles et al.(US 6,443,823), Applicants argue (See pages 4-6 of the response dated 4/30/2008) that the rejection is improper because the substrate of Law et al. is a rigid substrate while the instant claims and invention require a compliant agar plate. As a result, one of ordinary skill in the art would not modify the Law et al. device to include a pusher whereby the pins of the replicating pad are pushed into engagement with the compliant agar plate. Applicants also argue that the reference of Tolles is deficient for the same reasons as Law et al.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a compliant agar plate") are not positively recited structures in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the device of the modified primary reference is structurally the same as that instantly claimed. That is, the modified device of Law et al. includes a pusher device that is structurally the same as that instantly claimed and is capable of being operated in the manner intended in the instant claim language.

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. With respect to Applicants' comments: "*Specifically there is no reason why the Law device would want to push a released pad into a rigid substrate. Further there is nothing in Law that would teach, suggest or motivate a skilled person to modify the Law et al. device to include a pusher whereby the pins of the replicating pad are pushed into engagement with the compliant agar plate.*", the Examiner maintains that the reference of Law clearly provides motivation for the use of a pusher in addition to a positioning device. Specifically, the reference of Law discloses that the use of a pushing device allows uniform contact pressure to be applied across the substrate surface (See column 8, lines 47-59).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM H. BEISNER whose telephone number is (571)272-1269. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:15am to 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/William H. Beisner/
Primary Examiner
Art Unit 1797**

WHB